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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

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OFFICE OF PETITIONS

In re Application of	:
Staimer et al	: DECISION REFUSING STATUS
Application No. 10/828,732	: UNDER 37 CFR 1.47(a)
Filed: April 21, 2004	:
Attorney Docket No. NAGACO.215A	:

This is a decision in response to the petition under 37 CFR 1.47(a) filed on November 1, 2004 (certificate of mailing October 28, 2004). Petitioner obtained a two-month extension of time to reply. Accordingly, the petition is filed timely.

The petition is **DISMISSED**.

Petitioner is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time under 37 CFR 1.136(a) are permitted.

On April 21, 2004, petitioner filed the above-identified application without an executed oath or declaration. On June 29, 2004, the Office of Initial Patent Examination mailed a Notice to File Missing Parts of Nonprovisional Application, stating that the oath or declaration was missing, and requiring a surcharge for its late filing.

On November 1, 2004 (certificate of mailing October 28, 2004), petitioner submitted the present petition with an executed declaration listing only four joint inventors, Staimer, Chen, Norton and Jison. Petitioner requests that the Commissioner accept the filing of the above-identified application by joint inventors Staimer, Chen, Norton and Jison on behalf of themselves

and nonsigning inventor, Johnny Chen Mounphoxay. However, the declaration submitted by petitioner did not list Mounphoxay as a named inventor nor did he executed the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and,
- (4) a statement of the last known address of the non-signing inventor.

The petition lacks item (2) above.

The declaration filed on November 1, 2004, does not list Mounphoxay as a joint inventor. 37 CFR 1.41(a)(1) defines the inventorship of a nonprovisional application as that inventorship set forth in the oath or declaration as prescribed by 37 CFR 1.63. Mounphoxay is not listed as a joint inventor on the declaration. Therefore, he is not a part of the inventive entity. If petitioner wishes to add Mounphoxay as a joint inventor, a petition under 37 CFR 1.48, or a petition under 1.183 to waive 1.48, if appropriate, must be filed as described below.

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

- (1) a petition including a statement from each person being added and each person being deleted as an inventor that the error occurred without deceptive intention on his or her part;
- (2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47;
- (3) the fee set forth in 37 CFR 1.17(i), and
- (4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

Petitioner should request that Mounphoxay sign a statement of lack of deceptive intent. If an inventor's statement cannot be obtained, then upon a showing of extraordinary circumstances, such that justice requires, petitioner may seek waiver under 37 CFR 1.183 of that part of the regulation.¹ Petitioner must show that the inability to obtain the statement from Mounphoxay is, notwithstanding the exercise of reasonable care and diligence, due to circumstances beyond petitioner's control.² If Mounphoxay refuses to sign the statement of lack of deceptive intent, petitioner should provide proof that the statement of lack of deceptive intent was sent or given to him by providing a copy of the cover letter transmitting the statement of lack of deceptive intent to Mounphoxay or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

If Mounphoxay refuses in writing to sign the statement of lack of deceptive intent, a copy of the written refusal should be submitted with any renewed petition. If the refusal was made orally to a person, that person must provide details of the refusal in an affidavit or declaration of facts.

If the statement of lack of deceptive intent is returned as undeliverable, petitioner may provide proof that diligent efforts have been made to locate Mounphoxay by providing a copy of an envelope showing that a letter sent to the last known address of Mounphoxay was returned as undeliverable by the post office. Details of the efforts made to locate Mounphoxay should be set forth in an affidavit or declaration of facts by a person having first hand knowledge of the details.

The Office further notes that the declaration submitted is defective because petitioner failed to list Mounphoxay as a joint inventor, as well as provide his citizenship, mailing address, and residence. Petitioner must provide the Office with a new declaration setting forth the citizenship, mailing address, and residence of the entire inventive entity, leaving the signature block blank as to Mounphoxay if he refuses to sign. The declaration must be signed by each of the signing inventors on behalf of the non-signing inventor.

¹See MPEP 201.03(B).

²Although there is no requirement for a showing under 37 CFR 1.47, it is nevertheless appropriate to apply the principles thereof for showing that an inventor is unavailable or cannot be found to the situation at hand. MPEP 409.03(d).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions